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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,925	10/24/2003	Michael J. Curtis	119-P-04	1595

7590 01/31/2006

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/691,925	CURTIS, MICHAEL J.	
	Examiner	Art Unit	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The bar first and second solid ends being “incapable of receiving a screw to hold said second member in position relative to said first member” (e.g., new claim 28, lines 2-3) is not believed to be supported in the original disclosure (MPEP § 2163). The bar ends being incapable of receiving a self-drilling, self-tapping screw, for example, is not inherent in the description of said bar in the original specification. The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claims and claim limitations (MPEP §§ 714.02 and 2163.06).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Biedermann, US 5,800,565, which discloses a first member comprising slide member **21** having a channel **31**, two sidewalls, and a hole for accommodating a screw **25** (Figure 3); a second member comprising slide member **22** having a bar **32** received within and secured to said channel (column 3, lines 46-67). (The first and second members may alternatively comprise slide members **29** and **30**, respectively.)

Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biedermann, US 5,800,565. Regarding claim 9, the second rather than the first member is rotatably connected to a prosthetic component (column 4, lines 4-30); interchanging bars and channels on the respective slide members would have been an obvious variant (MPEP § 2144.04; *In re Einstein*, 8 USPQ 167). Regarding claim 11, a screw hole through each of the sidewalls would have been obvious in order to more securely lock the adjusted position of the components with respect to one another or in order to provide an alternative location for a single screw so as to accommodate both right-handed and left-handed amputees or prosthetists.

Claims 8, 9, and 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kraemer, DE 39 37 379 A1: English abstract; figures. Regarding claim 1 and others, the first member encompasses the upper part **29** or the lower piece **18**, with the second member including at least the intermediate piece **25**.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraemer, DE 39 37 379 A1. A screw hole through each of the sidewalls would have been obvious in order to more securely lock the adjusted position of the components with respect to one another or in

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order to provide an alternative location for a single screw so as to accommodate both right-handed and left-handed amputees.

Claims 1-7, 10, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraemer, DE 39 37 379 A1, in view of Erickson, US 1,302,336. Kraemer lacks the threadably rotatable connection as claimed (e.g., present claim 1, last six lines). Erickson teaches such a connection for adjusting the leg length and the foot angle (page 1, lines 14-16). To incorporate the Erickson mechanism into the Kraemer prosthesis would have been obvious in order to eliminate the need for the variously sized discs **32** and to provide somewhat finer adjustments on leg length and foot angle, with further motivation having been provided by the advantages cited by Erickson at page 1, line 20 et seq. Regarding claims 4 and 5, the second member in this case comprises the intermediate piece **25**, the lower piece **18**, and component **40** (with the first member involving the upper part **29**).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 6,033,440:

Figure 5.

The Applicant's remarks have been considered but are deemed to be moot in view of the new grounds of rejection, which were necessitated by the added limitations pertaining to the bidirectional nature of the adjustability (e.g., claim 1, lines 18-23). Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738